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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,835	09/17/2003	Fritz Gestermann	22133-00006-US	2702
30678	7590	06/21/2005	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ LLP SUITE 800 1990 M STREET NW WASHINGTON, DC 20036-3425			BELL, BRUCE F	
			ART UNIT	PAPER NUMBER
			1746	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/663,835	<b>Applicant(s)</b> GESTERMANN ET AL.	
	<b>Examiner</b> Bruce F. Bell	<b>Art Unit</b> 1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13,15 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13,15 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/3/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

1. Applicant's election with traverse of group II, claims 13, 15, 18-21 in the reply filed on June 7, 2005 is acknowledged. The traversal is on the ground(s) that the claims 13, 15 and 18-21 are directed to a gas electrode that necessarily includes the process of claim 1. Hence, since these claims depend from claim 1 and include all features thereof, the restriction is improper and further the inventions should be allowed together under in re Ochiai guideline. This is not found persuasive because the gas diffusion electrode is improperly dependent on a method claim. Product claims can not depend on method but method can depend on product claims. See Ex Parte Forsyth 151 USPQ 55. Further, the gas diffusion electrode of the group II invention can be made in a materially different way as will be shown below in a rejection under 35 USC 102. Lastly, In re Ochiai guidelines state, that if the product is allowable, then the process of making the product is allowable and should be rejoined together. In this case, the product is not allowable as will be seen in the 35 USC 102 rejection below.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 13, 15, 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Zelenay et al (6,696,382).

Zelenay et al disclose a gas diffusion electrode being either a cathode or an anode, wherein the anode has a Pt catalyst and the cathode has a Pt-Ru catalyst. The catalyst material is made into an ink having purified water and a perfluorosulfonic acid ionomer in an amount to provide 20 to 80% by volume in the anode and cathode surfaces. See abstract. The catalyst materials may be supported or unsupported. See col. 2, lines 20-22. A solution of the perfluorosulfonic acid ionomer in alcohols is then added to the catalyst and water mixture to provide another mixture. This mixture is then agitated in a cooler to obtain a homogenous ink suitable for application to the appropriate anode or cathode side of the membrane. See col. 2, lines 25-29. The ink made above is placed in a cooler and continuously agitated while spraying the ink over the anode or cathode side of the membrane, anode or cathode conductive backings or onto anode and cathode decal blanks. See col. 2, lines 36-40. The above mixture can also be sonicated for between 2-30 minutes depending on the particular mixture and ink volume. See col. 3, lines 38-43. A cathode can be formed from an ink using Pt black catalyst that is unsupported, water and Nafion. See col. 4, lines 18-21. The anode and cathode inks of the invention can be applied to membranes, gas-diffusion electrode or backings or to Teflon decal blanks using either brush painting or spraying techniques. See col. 4, lines 26-28. Zelenay et al anticipates the applicants' instant invention as set forth in the instant claims with respect to the disclosure set forth above.

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The gas diffusion electrode product as set forth in the instant claims has been found in the prior art. The gas diffusion electrode of the prior art has a catalyst material and an ionomer material of Pt or Pt-Ru and an ionomer of Nafion, that is sprayed onto an electrically conductive support of a gas diffusion backing layer or onto a membrane or onto Teflon decal blanks. The catalyst laydown of  $10\text{mg}/\text{cm}^2$  for spraying and  $12\text{ mg}/\text{cm}^2$  for brushed solutions is disclosed.

Therefore, the catalyst load on the electrode is the same as that instantly claimed by the applicant. Zelenay et al therefore discloses a gas diffusion electrode meeting the applicants' instant claims since the final product appears to be the same. In a product by process claims burden is upon the applicant to show the product differences. See *In re Best* 195 USPQ 430 (CCPA 1977); *In re Brown* 173 USPQ 685; *In re Fessman* 180 USPQ 324.

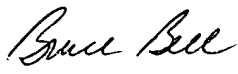
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce F. Bell whose telephone number is 571-272-1296. The examiner can normally be reached on Monday-Friday 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571 272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BFB  
June 19, 2005

  
Bruce F. Bell  
Primary Examiner  
Art Unit 1746